REMARKS

This Amendment is submitted in reply to the final Office Action mailed on May 14, 2010. No fees are due herewith this Amendment. The Director is authorized to charge any fees that may be required, or to credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 3712036-00486 on the account statement.

Claims 1, 3-4, 9-12 and 14-17 are pending in the application. Claims 2, 5-8 and 13 were previously canceled without prejudice or disclaimer. In the Office Action, Claims 9 and 14 are objected to. Claims 1, 3-4, 9-12 and 14-17 are rejected under 35 U.S.C. §103. In response, Applicants have amended Claims 3-4 and 9 and have canceled Claim 14 without prejudice or disclaimer. The amendments do not add new matter and are supported in the specification at page 2, lines 20-21. In view of the amendments and for at least the reasons set forth below, Applicants respectfully submit that the rejections should be withdrawn.

In the Office Action, Claims 9 and 14 are objected to for informalities. Specifically, Claim 9 is objected to because the claim allegedly recites the proportions without qualifying that the proportions are determined "by weight," as is indicated in independent Claim 1. See, Office Action, page 2, lines 8-10. In response, Applicants have amended Claims 3-4 and 9 to indicate that the proportions are determined "by weight." The amendments do not add new matter and are supported in the specification at, for example, page 2, lines 20-21. Accordingly, Applicants respectfully request that the objection to Claim 9 be reconsidered and withdrawn.

Regarding Claim 14, the Patent Office asserts that the limitations recited in dependent Claim 14 are already part of part Claim 12. See, Office Action, page 2, lines 15-17. In response, Applicants have canceled Claim 14 without prejudice or disclaimer. As such, Applicants respectfully submit that the objection of Claim 14 is now rendered moot.

In the Office Action, Claims 1, 3-4, 9-11, 15 and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,107,343 to Petricca ("*Petricca*") in view of the combination of Dictionary of Food ingredients by Igoe et al ("*Igoe*") and U.S. Patent No. 3,519,440 to Staackmann ("*Staackmann*"). Applicants respectfully submit, however, that the cited references, alone or in combination, fail to disclose or suggest each element of the rejected claims and that the skilled artisan would have no reason to combine the cited references because

the references teach away from each other and are directed toward products having completely different objectives.

Applicants submit that the cited references, alone or in combination, fail to disclose or suggest a milk product for providing at room temperature, either by shaking or with a foaming device, a foamed composition for beverages, the milk product comprising 0.3 to 3% propylene glycol monostearate by weight, 0.005 to 0.15% sorbitan tristearate by weight, and 0.005 to 0.015% unsaturated monoglyceride by weight as required, in part, by independent Claims 1 and 12. The Patent Office admits that *Petricca* fails to disclose unsaturated monoglycerides and their amount in the composition. See, Non-final Office Action, page 7, lines 9-11.

Applicants submit, however, that *Staackmann* fails to remedy the deficiencies of *Petricca*. *Staackmann* discloses 0.1% of a mixture of mono and diglycerides. See, *Staackmann,* column 5, Composition A. The 0.1% level is clearly outside the range of unsaturated monoglycerides in the present claims. Even the Patent Office asserts that *Staackmann* discloses "unsaturated monoglycerides and combinations thereof in the amount of 0.1%" by citing Composition A. Therefore, *Staackmann* fails to remedy the deficiencies of *Petricca*.

Similarly, *Igoe* also fails to remedy the deficiencies of *Petricca*. Instead, *Igoe* discloses definitions of Polyoxyethylene (20) Sorbitan Monostearate and Polyoxyethylene (20) Sorbitan Tristearate. See, *Igoe,* page 111. At no place in the disclosure does *Igoe* disclose or suggest the presently claimed amounts of any unsaturated monoglycerides. Therefore, *Igoe* also fails to remedy the deficiencies of *Petricca*.

Further, Applicants respectfully submit that the skilled artisan would have no reason to combine the cited references because the references teach away from each other and are directed toward products having completely different objectives. For example, *Petricca* is entirely directed to a pourable, whippable, edible emulsion containing water, fat, sweetener, protein, thickener, buffer and emulsifiers. See, *Petricca*, Abstract. As a result, *Petricca* teaches a non-dairy (non-milk) emulsion. Each example and each formulation described in *Petricca* reinforces the non-dairy nature of the emulsion. See, *Petricca*, column 2, Tables I and II, and columns 5-8, Examples 1-6. Though milk is mentioned in *Petricca*, it is only taught as a diluent for the finished product emulsion. Therefore, milk is not part of the emulsion invention of *Petricca*. Even the "disperable protein" of the emulsion is disclosed as sodium caseinate, which is a milk

derivative that is not a source of lactose and therefore an ingredient generally used in non-dairy products. In fact, Section 101.4(d) of Title 21 of the Code of Federal Regulations allows foods containing sodium caseinate to be labeled as non-dairy.

The Patent Office asserts that "applicant is referred to *Petricca* Column 3, line 1 to Column 4, line 63" where it is allegedly disclosed that the composition includes milk components and can also include milk. See, Office Action, page 14, line 28-page 15, line 2. However, Applicants reiterate that the mere fact that *Petricca* states that the emulsion may be diluted with milk does not change the fact that the entire reference, when viewed as a whole, is directed to a non-dairy (non-milk) emulsion. Indeed, the courts are clear that each reference in an obviousness rejection must be considered as a whole and those portions teaching against or away from each other and/or the claimed invention must be considered. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve Inc.*, 796 F.2d 443 (Fed. Cir. 1986). "A prior art reference may be considered to teach away when a person of ordinary skill, upon reading the reference would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the Applicant." *Monarch Knitting Machinery Corp. v. Fukuhara Industrial Trading Co., Ltd.*, 139 F.3d 1009 (Fed. Cir. 1998), quoting, *In re Gurley*, 27 F.3d 551 (Fed. Cir. 1994).

Further, each example and each formulation described in *Petricca* reinforces the non-dairy nature of the emulsion. See, *Petricca*, column 2, Tables I and II, and columns 5-8, Examples 1-6. As such, although milk is mentioned in *Petricca*, it is only taught as a diluent for the finished product emulsion. Therefore, milk is not part of the emulsion invention of *Petricca*.

In contrast to *Petricca*, *Staackmann* is entirely directed to providing a dairy product having storage stability and resistance to microbiological attack at room temperature. See, *Staackmann*, column 1, lines 49-68. Therefore, *Petricca* teaches essentially a non-dairy food product, which not only teaches away from *Staackmann*, but also teaches away from the present claims, which are directed to a milk product.

As such, the products and methods of the cited references explicitly teach away from the combination with each other and are directed toward products having completely unrelated objectives. Accordingly, the skilled artisan would have no reason to combine the cited references to arrive at the present claims. Indeed, it would be a stretch for the skilled artisan,

aimed at providing a milk product (dairy product) as claimed, to arrive at such a result by reviewing *Petricca*, which is aimed solely at providing a non-dairy whippable emulsion, in view of *Staackmann*, which is directed to a dairy product. Further, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there exists no reason for the skilled artisan to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

The Patent Office further states that "it would have been obvious to one of ordinary skill in the art at the time of the invention that sorbitan monostearate (*Petricca*) and sorbitan tristearate [*Igoe*] will function similarly when added to a whippable composition." See, Office Action, page 7, lines 12-16. Applicants respectfully disagree and submit that, on one hand, *Igoe* discloses that sorbitan monostearate is water-dispersable, very hydrophilic and is used in whipped toppings. On the other hand, however, *Igoe* discloses that sorbitan tristearate is dispersible in fat, oil and water and is used in frozen desserts and coffee whiteners. See, *Igoe*, page 111. In view of the differences in dispersibilities alone, Applicants respectfully disagree with the Patent Office's assertion that the two compounds would behave similarly, let alone as "functional equivalents." Indeed, as discussed in the specification, stability of foamed milk products is difficult to achieve due to, for example, sterilization and coagulation. Applicants submit that the skilled artisan would immediately appreciate that differences in dispersibility can cause serious impacts on stability of such products and, as a result, would not find sorbitan monostearate and sorbitan tristearate to be functional equivalents.

Applicants respectfully submit that what the Patent Office has done here is to apply hindsight reasoning by attempting to selectively piece together teachings of each of the references in an attempt to recreate what the claimed invention discloses. Applicants also submit that if it were proper for the Patent Office to combine any references to arrive at the present claims simply because each reference suggests an element of the present claims, then every invention would effectively be rendered obvious. Instead, the skilled artisan must have a reason to combine the cited references to arrive at the present claims. Applicants respectfully submit that such a reason is not present in the instant case.

The Patent Office asserts that "Applicant has not presented any concrete reasoning or evidence to show why one skilled in the art would not have made the modification as set forth in

the rejection." See, Office Action, page 15, lines 25-27. Applicants respectfully disagree for at least the reasons set forth above. As is discussed in detail above, a showing that cited references teach away from each other rebuts a finding of obviousness. Further, the courts are clear that each reference in an obviousness rejection must be considered as a whole and those portions teaching against or away from each other and/or the claimed invention must be considered. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve Inc.*, 796 F.2d 443 (Fed. Cir. 1986). Since Applicants have clearly demonstrated why the cited references teach away from each, Applicants have, in contrast to the Patent Office's statement, presented reasoning to show why one skilled in the art would not have made the modification as set forth in the rejection.

Accordingly, Applicants submit that *Petricca, Igoe* and *Staackmann*, alone or in combination, fail to disclose or suggest each element of the rejected claims and are not combinable because the references teach away from each other and are directed toward products having completely different objectives.

In the Office Action, Claims 12, 14 and 16 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Petricca* in view of the combination of *Igoe, Staackmann,* and further in view of U.S. Patent No. 4,888,194 to Anderson et al. ("*Anderson*"). For the same reasons stated above with regard to independent Claim 1, *Petricca, Igoe* and *Staackmann* fail to disclose or suggest a milk product comprising 0.3 to 3% propylene glycol monostearate (PGMS) by weight, 0.005 to 0.15% sorbitan tristearate (STS) by weight, and 0.005 to 0.015% unsaturated monoglyceride by weight as required, in part, by independent Claim 12. Applicants submit that *Anderson* fails to remedy the deficiencies of *Petricca, Igoe* and *Staackmann.*

The Patent Office relies on *Anderson* to teach the method steps adding emulsifiers to skim milk and then adding cream as a source of fat to the emulsion. See, Office Action, page 15, line 10 to page 16, line 17. Moreover, *Anderson* teaches adding about 0.4% to about 1.0% by weight of an added monoglyceride emulsifier to the dairy product of *Anderson*. See, *Anderson*, Claim 1; column 2, lines 35-43; and column 3, lines 12-21. The monoglyceride levels taught in *Anderson* clearly exceeds the range of the present claims. Therefore, *Anderson* fails to remedy the deficiencies of *Petricca, Igoe* and *Staackmann*.

Further, for reasons similar to those set forth above, Applicants respectfully submit that the skilled artisan would have no reason to combine the cited references because the references

teach away from each other and are directed toward products having completely different objectives. For example, *Petricca* is entirely directed to a pourable, whippable, edible emulsion containing water, fat, sweetener, protein, thickener, buffer and emulsifiers. See, *Petricca*, Abstract. As a result, *Petricca* teaches a non-dairy (non-milk) emulsion. Each example and each formulation described in *Petricca* reinforces the non-dairy nature of the emulsion. See, *Petricca*, column 2, Tables I and II, and columns 5-8, Examples 1-6. Though milk is mentioned in *Petricca*, it is only taught as a diluent for the finished product emulsion. Therefore, milk is not part of the emulsion invention of *Petricca*.

In contrast to *Petricca*, *Staackmann* is entirely directed to providing a dairy product having storage stability and resistance to microbiological attack at room temperature. See, *Staackmann*, column 1, lines 49-68. Similarly, *Anderson* is entirely directed to providing a shelf-stable aseptic dairy product. See, *Anderson*, Abstract. Therefore, *Petricca* teaches essentially a non-dairy food product, which not only teaches away from *Staackmann*, but also teaches away from *Anderson* and the present claims, which are directed to a milk product.

Accordingly, Applicants respectfully request that the obviousness rejections with respect to Claims 12, 14 and 16 be reconsidered and the rejections be withdrawn.

For the foregoing reasons, Applicants respectfully request reconsideration of the above-identified patent application and earnestly solicit an early allowance of same. In the event there remains any impediment to allowance of the claims which could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate such an interview with the undersigned.

Respectfully submitted,

K&L GATES LLP

BY _____

Robert M. Barrett
Reg. No. 30,142
Customer No. 29157
Phone No. 312-807-4204

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